

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte H. JAY SPIEGEL

Appeal No. 97-1566
Application 29/033,924¹

ON BRIEF

KRASS, STAAB and WALTZ, *Administrative Patent Judges.*

STAAB, *Administrative Patent Judge.*

DECISION ON APPEAL

Jay Spiegel (appellant) appeals from the final rejection of the claim in this design application to:

The ornamental design for a KICKING TEE as shown and described.

The examiner relies on the following references as evidence of obviousness:

¹Application for patent filed January 24, 1995.

Appeal No. 97-1566
Application 29/033,924

Spiegel Des. 291,714 Sept. 1, 1987

Hornung, Handbook of Designs and Devices, Plate No. 1711 (1946)
p. 191.

The claim stands rejected under 35 U.S.C. § 103 as being unpatentable over Spiegel in view of Hornung. The examiner's findings regarding the content of the references and the differences between the claimed invention and Spiegel are stated as follows (examiner's answer, page 3):

The patent to Spiegel is cited to show a kicking tee which is strikingly similar to that of the claimed design except for the difference in the shape of the outer portion.

The reference to Handbook of Design and Devices (Figure 1711) is cited to show a shield shape which is substantially similar in overall appearance to the shape of the outer portion of the claimed design.

The examiner concludes that it would have been obvious to substitute the shield shape of Figure 1711 for the outer shape of Spiegel, and further that "by simply modifying the outer shape, since the interior portions of the kicking tee [of Spiegel and the claimed design] are almost identical, said modification would produce and [sic, an] article strikingly similar in appearance to that of the claimed design" (examiner's answer, page 3).

In the "Response to argument" section of the answer, the examiner offers additional views regarding the combinability of the references. Specifically, the examiner states that "as long

as the primary reference is analogous, secondary references can be properly combined In this respect, secondary references need not be analogous to the claimed design" (examiner's answer, pages 3-4). The examiner also states that

[because] the Spiegel patent discloses a kicking tee which is overwhlemingly [sic] similar in overall general appearance to that of appellant's claimed 'Kicking Tee', the modifications to the outer shape by means of substituting one well-known geometric shape for another well-known shape as discussed above are obvious and well within the skill of an ordinary designer. [examiner's answer, page 5]

Appellant's arguments in support of patentability can be found in the main brief (pages 3-11) and the reply brief.

We have carefully evaluated appellant's depicted design, the designs shown by the Spiegel patent and the Hornung handbook relied upon by the examiner, and the respective positions advocated by appellant and the examiner. As a result thereof, we have reached the conclusion that the examiner's rejection of appellant's design claim under 35 U.S.C. § 103 is not well founded. Our reasoning for this determination follows.

We will concede to the examiner that the primary reference to Spiegel qualifies as a *Rosen* reference, that is, a proper starting point to support a holding of obviousness.² We will

²When a § 103 rejection is based upon a combination of references, "there must be a reference, a something in existence,

also concede to the examiner that the Hornung handbook establishes that shield shapes are generally known to the ordinarily skilled designer. However, contrary to that which the examiner would apparently have us believe, these circumstances alone do not establish that it would have been obvious to combine Spiegel and a particular one of Hornung's shield shapes as proposed by the examiner to arrive at the presently claimed design.

Regarding combining references in design cases, we note, as the court did in *In re Glavas*, 230 F.2d 447, 450, 109 USPQ 50, 52 (CCPA 1956), that

[o]bviously, almost every new design is made up of elements which, individually, are old somewhere in the prior art, but the fact that the individual elements of a design are old, does not prove want of invention in assembling them.

This is so because, generally speaking, when the proposed combination of references in a design case involves material modification of the basic form of one article in view of another, the references applied must be so related that the appearance of certain ornamental features in one would suggest the application

the design characteristics of which are basically the same as the claimed design in order to support a holding of obviousness." *In re Rosen*, 673 F.2d 388, 391, 213 USPQ 347, 350 (CCPA 1982).

of those features to the other. *See In re Glavas, supra.*

In our opinion, the modification proposed by the examiner involves a material modification of the basic form of Spiegel's ornamental design. However, we find nothing in the combined teachings of the applied references which indicates that an ordinarily skilled designer who designs articles of the type involved here, namely, kicking tees, would consider the ornamental shapes depicted in the Hornung handbook to be so related to the design of kicking tees to suggest application of a shield shape to the outer shape of the article depicted in the Spiegel patent. The examiner has provided no cogent line of reasoning which would suggest or justify such a substantial change in the basic form of the kicking tee design of Spiegel, in our view. Rather, the examiner appears to be of the view that it would have been *per se* obvious to one ordinary skill in the kicking tee design art to substitute any known geometric shape for the rounded oval shape of Spiegel notwithstanding that there is no suggestion in the prior art to combine the references and their visual appearances. This is just the sort of mechanical approach to the question of obviousness criticized by the court in *In re Harvey*, 12 F.3d 1061, 1065, 29 USPQ2d 1206, 1209 (Fed. Cir. 1993) ("If we adopted the logic of the Board . . . each and

every prior art bowl or vase shape ever publicly disclosed would render obvious any generally similar vase shape. Clearly, this cannot be the case.").

Further, and perhaps more importantly, even if we were to accept that it would have been obvious as a general principle to modify the outer shape of Spiegel by making it shield shaped in view of Hornung's teaching that such shapes are known, we do not agree with the examiner's implied position that the claimed ornamental design would necessarily ensue. In this regard, the examiner appears to be of the view that the designer of ordinary skill who designs articles of the type involved here would have found it obvious to select a particular portion of a particular one of Hornung's shield variants (namely, one of the light portions of the 1711 shield variant) and apply it to Spiegel in a particular manner (i.e., such that the rounded portion of Spiegel's cavity is located in the pointed lower end of the shield with the periphery of the rounded portion closely "mimicking" the outer periphery of the shield's pointed lower end). However, it is not apparent to us why an ordinarily skilled designer would be so inclined based on the teachings of the references themselves. Where prior art references require a selective combination to render obvious a claimed invention,

Appeal No. 97-1566
Application 29/033,924

there must be some reason for the combination other than hindsight gleaned from the invention disclosure. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985).

From our perspective, what the examiner has done here is to impermissibly rely upon appellant's own disclosed design for a suggestion to modify the kicking tee of the Spiegel patent to arrive at the presently claimed ornamental design. This is improper.

The decision of the examiner is reversed.

REVERSED

ERROL A. KRASS)	
Administrative Patent Judge)	
)	
)	
)	
LAWRENCE J. STAAB)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
THOMAS A. WALTZ)	
Administrative Patent Judge)	

Appeal No. 97-1566
Application 29/033,924

H. Jay Spiegel
P.O. Box 20202
Alexandria, VA 22320